

REMARKS

1. Applicant thanks the Examiner for her generous assistance, provided during a telephone interview on September 29, 2009. During said interview, Applicant pointed out to the Examiner that there was no teaching or suggestion in Hertzog of the subject matter "wherein a subscriber of said resource can modify published information in a local copy of said resource, said modified published information being overwritten by any update published by said publisher." The Examiner disagreed with Applicant, maintaining her position that the combination did teach or suggest the subject matter in question. Applicant noted that the Examiner's position, in view Hertzog's clear teachings, was unsustainable and raised an appealable issue. The Examiner advised Applicant to amend the Claims to describe the subject matter more clearly.

2. OBJECTIONS TO THE CLAIMS

Claims 1, 12, 25 and 63 are objected to due to the use of the expression "said users can be" Response thereto, Applicant has inserted appropriate corrections. The present objection is therefore deemed overcome.

3. 35 U.S.C. § 103

Claims 1-6, 8-9, 12-19, 21-22, 25-33, 35-36, 38-40, 42-47 51-52, 55-57, 63-70, 72-76, 78-82, 86, 87 and 90-92 are rejected as being unpatentable over U.S. patent application pub. no 2003/0069874 ("Cheah") in view of U.S. patent application pub. no. 2003/0069874 ("Hertzog") and further in view of U.S. patent no. 6,820,204 ("Desai").

The Office relies on Hertzog, Figs.3, 5 and 22a and ¶¶ 0067, 0079, 0080, 0082 and 0089 as teaching or suggesting "wherein a subscriber of said resource can modify published information in a local copy of said resource, said modified published information being overwritten by any update published by said publisher." Applicant respectfully disagrees. Hertzog's Fig. 5 shows a set of contact information 82, which

comprises published fields 84 and unpublished fields 86. The published fields 84 contain information that is generated by the publishing user (§ 0079). Additionally, the information populating the published fields is owned by the publishing user (§ 0089). Because the owner-user does not own the data, the owner user cannot alter or modify the information contained in the published fields 84, although the publishing user, as the data owner, can modify the information in the published fields 84. Similarly, because the information in the unpublished fields is not owned by the publishing user, the publishing user may not modify it. However, the owner-user, as the owner of the unpublished information may modify or alter the information contained in the unpublished fields. Incorrectly, the Examiner interprets the ability of the owner-user to attach unpublished information 86 to the published information 84 in the set of contact information 82 as modifying the published information. Applicant respectfully disagrees with the Examiner's interpretation. The correct interpretation is that the owner-user is able to modify the set of contact information by attaching unpublished information 86. The published information remains unmodified. Accordingly, it is incorrect that Hertzog teaches or suggests "wherein a subscriber of said resource can modify published information in a local copy of said resource, said modified published information being overwritten by any update published by said publisher."

Nonetheless, in the interest of advancing prosecution of the Application, Applicant amends Claim 1 to describe "wherein a subscriber of said resource can edit published information in a local copy of said resource, said edited published information being overwritten by any update published by said publisher." Support for the amendment is found at least at § 0122 of U.S. patent application pub. no. 2004/0267625. Thus, as amended, Claim 1 describes that the subscriber can edit published information in its own local copy of the publisher's address card. In other words, unlike Hertzog, the subscriber can make changes directly to the published information. However, when the publisher updates the published information, the edits are overwritten. As Applicant has shown above, there is no teaching or suggestion of such subject matter in Hertzog. The remaining references of the combination have nothing to add to Hertzog. Thus, there is no teaching or suggestion in the combination

of "wherein a subscriber of said resource can edit published information in a local copy of said resource, said edited published information being overwritten by any update published by said publisher." Thus, the combination fails to teach or suggest all elements of the independent Claims.

Additionally, there would be no motivation for the practitioner of ordinary skill to combine the references because both Cheah and Hertzog are engineered specifically to restrict sharing of information, to the extent, for example, that Cheah's client does not even function on an unregistered user's computer. Therefore, at least implicitly, the combination teaches away from the invention.

In view of their dependence from an allowable parent claim, Claim 1's dependent Claims are deemed allowable without any separate consideration of their merits.

The remaining independent Claims are amended in the same manner as Claim 1 and are therefore allowable for the same reasons that Claim 1 is allowable. In view of their dependence from allowable parent claims, the remaining dependent Claims are deemed allowable without any separate consideration of their merits

Claims 11 and 24 are rejected as being unpatentable over Cheah/Hertzog/Desai and further in view of Hu. In view of the foregoing, the present rejection is deemed improper/overcome.

Claims 34, 49, 62, 71, 84 and 97 are rejected as being unpatentable over Cheah/Hertzog/Desai and further in view of Tornabene. In view of the foregoing, the present rejection is deemed improper/overcome.

Claims 50 and 85 are rejected as being unpatentable over Cheah/Hertzog/Desai and further in view of Tornabene and Chen. In view of the foregoing, the present rejection is deemed improper/overcome.

Claims 48 and 83 are rejected as being unpatentable over Cheah/Hertzog/Desai and further in view of Padwick and Slipstick. In view of the foregoing, the present rejection is deemed improper/overcome.

Claims 53-54, 58-59, 88-89 and 93-94 are rejected as being unpatentable over Cheah/Hertzog/Desai and further in view of Padwick. In view of the foregoing, the present rejection is deemed improper/overcome.

Claims 60 and 95 are rejected as being unpatentable over Cheah/Hertzog/Desai and further in view of Padwick and Microsoft Technet. In view of the foregoing, the present rejection is deemed improper/overcome.

4. NEW CLAIMS

New Claims 98-102 are added to the Application. Support for new Claims 98-101 is found at least at ¶ 0020 of the Application Publication. Support for new Claim 101 is found at least at ¶¶ 0020-0160.

5. No new matter is added by way of the foregoing amendments. Such are made only to advance prosecution of the Application in deference to the Office policy of compact prosecution. They do not indicate agreement by Applicant with the Office's position; nor do they reflect intent to forsake Claim scope. In fact, Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to in future filings with the Office.

For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

CONCLUSION

In view of the foregoing, the Application is deemed in allowable condition. Accordingly, Applicant respectfully requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions regarding the Application, she is invited to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'M. A. Glenn', with a long horizontal flourish extending to the right.

Michael A. Glenn
Reg. No. 30,176

Customer No: 22862